

The opinion in support of the decision being entered
today is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SHELL STERLING SIMPSON, WARD SCOTT FOSTER,
and KRIS R. LIVINGSTON

Appeal No. 2007-0781
Application No. 10/003,150
Technology Center 3600

Decided: September 19, 2007

Before TERRY J. OWENS, MURRIEL E. CRAWFORD, and
HUBERT C. LORIN, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

This is an appeal from a decision of the Examiner rejecting claims
1-4, 7, 11-13, and 30.¹ 35 U.S.C. § 134 (2002). We have jurisdiction under
35 U.S.C. § 6(b) (2002).

¹ Claims 5, 6, 8-10, and 14-29 have been canceled.

The invention relates to a pay-for-printing method. (Specification 1: 4-5).

The claims are rejected as follows:

- Claims 1-4, 7, 11, 13, and 30 are rejected under 35 U.S.C. § 102(e) as being unpatentable over Garfinkle (US Patent 6,924, 878).
- Claim 12 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Garfinkle in view of Official Notice.

We AFFIRM.²

The rejection of claims 1-4, 7, 11, 13, and 30 under 35 U.S.C. § 102(e) over Garfinkle.

Appellants, in the Appeal Brief, argued the claims together. Because Appellant argued the claims as a group, pursuant to the rules, the Board selects representative claim 1 to decide the appeal with respect to this rejection, and claims 2-4, 7, 11, 13, and 30 will stand or fall with claim 1. 37 C.F.R. § 41.37(c)(1)(vii) (2006). Claim 1 reads as follows:

1. A method for facilitating pay printing, the method comprising:
a network-based printing service retrieving a scaled-down version of a full-sized document to be printed from at least one store via a network;
the printing service receiving print option selections; and
the printing service determining printing costs for printing the full-size document based upon attributes of the scaled-down version.

² Our decision will make reference to Appellants' Appeal Brief ("Appeal Br.," filed Jun. 26, 2006), the Examiner's Answer ("Answer," mailed Aug. 25, 2006), and to the Reply Brief ("Reply Br.," filed Sep. 29, 2006).

A. ISSUE

The issue is whether Appellants have shown error in the rejection.

B. FINDINGS OF FACT

The record supports the following findings of fact (FF) by a preponderance of the evidence.

1. The Examiner found that Garfinkle discloses the claimed subject matter, as follows:

In regards to claim 1, Garfinkle discloses a method for facilitating pay printing (abstract), the method comprising:
a network-based printing service retrieving a scaled-down version of a full-sized document to be printed from at least one store via a network (col 6, lines 1-25);
the printing service receiving print option selections (col 6, lines 1-25); and
the printing service determining printing costs for printing the full-sized document based upon attributes of the scaled-down version (col 9, lines 53-65).

(Answer 3.)

2. Col. 6, ll. 1-25 of Garfinkle reads as follows:

In a most preferred embodiment, the photographer 8 accesses HTML pages from a WWW browser using either the Secure HyperText Transport Protocol (HTTPS) or HyperText Transport Protocol (HTTP) to access a Netscape Enterprise Server running on an Axil 320 Sparc acting as the image server. The Netscape server is configured with an HTML forms interface which accepts the unique access code and provides access to thumbnails (small replicas of the full digital image) of the images in the roll in the form of an online proof sheet. The interface B allows the photographer 8 to perform specific tasks using the digital images, such as the ability to electronically mail (email) an image to another party; download an image to the photographer's home computer 9f, see FIG. 9C; or order

a visual print of a specific image in a variety of formats and sizes, such as photographic prints or enlargements of photographic prints, and photographic merchandise including T-shirts, sweatshirts, mugs, mouse pads, puzzles, ties, buttons, electronic slide shows, and other items bearing the digital image.

It will be appreciated that when downloading or e-mailing a digital image, the resolution of the digital image is preferably reduced to a screen size of 600x400 pixels or 712x512 pixels. These sizes are more appropriate for screen display of the digital images, and also faster transfer of the data over a network.

3. Col. 9, ll. 53-65 of Garfinkle reads as follows:

When the photographer 8 uploads one or more digital images directly to the image server 16, these images are either added to a set of images already associated with an access code or the new images are assigned a new unique access code. When a new access code is assigned, a price sheet must be associated with these images in order to provide to the photographer 8, the visual prints which may be ordered using the new images. In a preferred embodiment, the photographer 8 selects a fulfillment center 20 which they prefer to use to fulfill all orders placed using the new images. A price sheet is associated with each fulfillment center 20, and this price sheet forms the basis for the products available to the photographer 8, and the prices of these products.

4. Appellants argued that Garfinkle does not anticipate the claimed subject matter because it does not teach (1) “a network-based printing service retrieving a scaled-down version of a full-sized document to be printed from at least one store via a network” [i.e., the first step of the claimed method] (Appeal Br. 6-7) or (2) “the printing service determining printing costs for printing the full-sized document based upon attributes of the scaled-down version” [i.e., the third step of the claimed method] (Appeal Br. 7-8).

5. Regarding limitation (1), Appellants argued that the passage at col 6, ll. 1-25 of Garfinkle that the Examiner relied upon to show that Garfinkle describes this limitation refers to a “photographer, not any ‘network-based printing service’ can retrieve an online proof sheet that contains small replicas of his images.” Appeal Br. 7.

6. The Examiner responded as follows:

Appellant argues that Garfinkle does not teach a network based printing service and that in Garfinkle the photographer, not any “network based printing service,” can retrieve an online proof sheet that contains small replicas of his images. The examiner disagrees and notes that Appellant argues that only the photographer receives the thumbnails inferring that the photographer is not part of the system. The examiner disagrees on two levels (1) in Garfinkle, the photographer refers to any party having authorization to view the images (col 3 – col 4, lines 1-10³), such as when an operator accessing these images (col 9, lines 5-21) and (2) the examiner understands the appellant’s invention in relation to a printing service to be more than that described in item 318 of Figure 3 as stated by appellant and considers the “network based printing service” to encompass all of figures 1-9.

(Answer 6.)

7. Appellants responded by arguing in part that, notwithstanding that Garfinkle defines “photographer” broadly [see footnote 3], “Garfinkle does not consider a printing service as an entity that qualifies as a “photographer,” and neither would a person having ordinary skill in the art.” Reply Br. 5-6.

8. Regarding limitation (2), Appellants argue that the passage at col 9, ll. 53-65 of Garfinkle that the Examiner relies upon to show that Garfinkle

³ “As used herein, the “photographer” refers to any party having authorized access to the images and is not necessarily limited to the party that took the pictures.”

describes this limitation misses “a teaching of determining printing costs based upon ‘attributes’ of ‘scaled-down versions’ of images.” Appeal Br. 8.

9. The Examiner responded as follows:

Appellant argues that Garfinkle does not teach [the printing service] “determining printing costs for printing the full-sized document based upon attributes of the scaled-down version”. Based on the above definitions, Garfinkle clearly teaches thumbnail prints being downloaded to a user to decide which prints are desired and also to see if there are alternative products that are desired by the user (col 6, lines 1-25, col 8, lines 33-40. The pay for print system of Garfinkle uses price sheets to calculate the costs associated with desired products selected by the user to arrive at a price for the order (col 9).

(Answer 6-7.)

10. According to the Examiner, “[b]ased on applicant’s disclosure the examiner takes this term ‘print service web content’ to mean the entire pay-for-print process as is defined in FIG 8A and page 26, lines 11-21 [of the Specification].” Answer 5. However, the term “print service web content” does not appear anywhere in the cited Fig. or passage.

11. According to the Examiner, “[t]he examiner cannot find an exact correlation to this feature [“determining printing costs based upon attributes of the scaled-down version”] in applicant’s specification. ... The examiner understands the process to be downloading the thumbnail to a user so that the user can view the document/thumbnail to see if the image is desirable or printable.” Answer 5-6.

12. Appellants responded by arguing that “the Examiner argues that Garfinkle teaches a ‘printing service determining printing costs for printing the full-sized document based upon attributes of the scaled-down version’ because the ‘photographer’ can view his images in thumbnail form.

Applicant has addressed this issue above. In short, there is no reasonable basis to interpret a ‘printing service’ ‘determining printing costs’ from attributes of a scaled-down version of a document as the photographer merely reviewing [sic, reviews] his images.” Reply Br. 6-7.

C. PRINCIPLES OF LAW

Anticipation is a question of fact. *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997).

It is well settled that in order for the examiner to establish a *prima facie* case of anticipation, each and every element of the claimed invention, arranged as required by the claim, must be found in a single prior art reference, either expressly or under the principles of inherency. *See generally, Schreiber*, 128 F.3d at 1477, 44 USPQ2d at 1431; *Diversitech Corp. v. Century Steps, Inc.*, 850 F.2d 675, 677-78, 7 USPQ 1315, 1317 (Fed. Cir. 1988); *Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick*, 730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984).

There must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. *Scripps Clinic & Research Found. v. Genentech Inc.*, 927 F.2d 1565, 1576, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991).

D. ANALYSIS

We will not sustain the rejection because, after a careful review of Garfinkle, we are unable to find any explicit teaching of a “network-based printing service” to retrieve a scaled-down version of a full-sized document to be printed from at least one store via a network as required by the claim.

The Examiner's line of reasoning leading to the conclusion that the claimed invention is anticipated by Garfinkle depends, in part, on interpreting Garfinkle's use of the term "photographer" as encompassing an operator of a printing service having authorization to access thumbnails which can be later printed. FF 6. We agree with Appellants (see FF 5) that the passage at col 6, ll. 1-25 of Garfinkle that the Examiner relied upon to show that Garfinkle describes this limitation refers to a photographer, not any "network-based printing service." We are unable to find any indication in Garfinkle that "photographer" has been given a meaning other than what one of ordinary skill would normally give it, namely a person taking photographs. We do not find that a "network-based printing service" is inherently disclosed by the fact that Garfinkle discloses a "photographer." Furthermore, the Examiner does not show that Garfinkle provides "a teaching of determining printing costs based upon "attributes" of scaled-down versions" of images." See FF 8. The Examiner attempts to construe the claim broadly so that *printing service* would cover the entire printing process. FF 9-12. However, we find nothing in Garfinkle that speaks to determining printing costs based upon "attributes" of a scaled-down version.

The question is one of anticipation. As such, there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. We are not persuaded that a person of ordinary skill in the field of the invention viewing Garfinkle and the claimed invention would conclude that there is no difference between the two.

E. CONCLUSION OF LAW

On the record before us, Appellants have shown that the Examiner erred in rejecting claim 1 as being anticipated over Garfinkle.

The rejection of claim 12 under 35 U.S.C. § 103(a) as being over Garfinkle in view of Official Notice.

Claim 12 reads as follows:

12. The method of claim 11⁴, wherein the printing service is supported by a printing device having an embedded server.

In rejecting claim 12, the Examiner focuses solely on the subject matter set forth in claim 12. The subject matters of claims 1 and 11 from which claim 12 depends, and which claims 12 includes, are not addressed. Answer 4. We presume therefore that, with respect to the subject matter of claims 1 and 11, the Examiner maintains that Garfinkle describes, for example, explicitly or inherently, the claimed “network-based printing service” to retrieve a scaled-down version of a full-sized document to be printed from at least one store via a network. Since, for the reasons we discussed supra, we do not find that Garfinkle explicitly or inherently describes at least the claimed “network-based printing service” to retrieve a scaled-down version of a full-sized document to be printed from at least one store via a network, we can not sustain this rejection.

⁴ “11. The method of claim 1, wherein receiving print option selections comprises receiving user selections with a web site of the network-based printing service.”

REMAND

Notwithstanding that we reverse the rejections of the claims, we nevertheless remand the application to the Examiner to consider whether claims 1-4, 7, 11, 13, and 30 should be rejected over Garfinkle under 35 U.S.C. §103(a) rather than 35 U.S.C. §102(e).

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int’l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734, 82 USPQ2d 1385, 1391 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, and (3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966). *See also KSR*, 127 S.Ct. at 1734, 82 USPQ2d at 1391 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”) The Court in *Graham* further noted that evidence of secondary considerations “might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.” 383 U.S. at 18, 148 USPQ at 467.

In *KSR*, the Supreme Court emphasized “the need for caution in granting a patent based on the combination of elements found in the prior art,” *id.* at 1739, 82 USPQ2d at 1395, and discussed circumstances in which a patent might be determined to be obvious.

In particular, the Supreme Court emphasized that “the principles laid down in *Graham* reaffirmed the ‘functional approach’ of *Hotchkiss*, 11 How. 248.” *KSR*, 127 S.Ct. at 1739, 82 USPQ2d at 1395 (citing *Graham*, 383 U.S. at 12, 148 USPQ at 464 (emphasis added)), and reaffirmed principles based on its precedent that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Id.* The Court explained:

When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, §103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.

Id. at 1740, 82 USPQ2d at 1396. The operative question in this “functional approach” is thus “whether the improvement is more than the predictable use of prior art elements according to their established functions.” *Id.*

The Supreme Court made clear that “[f]ollowing these principles may be more difficult in other cases than it is here because the claimed subject matter may involve more than the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for the improvement.” *Id.* The Court explained, “[o]ften, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the

marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.” *Id.* at 1740-41, 82 USPQ2d at 1396. The Court noted that “[t]o facilitate review, this analysis should be made explicit.” *Id.*, citing *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”). However, “the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *Id.*

We have established that the difference between what Garfinkle discloses and the claimed subject matter is that the claimed method includes a network-based printing service retrieving a scaled-down version of a full-sized document to be printed from at least one store via a network and a printing service determining printing costs for printing the full-sized document based upon attributes of the scaled-down version.

However, printers retrieving scaled-down versions of a full-sized document over a network are well known. Printers that print full size documents over a network are well known, as are printers which can print scaled-down versions of full-sized documents.

Basing printing costs on attributes of a document is also well known. The specification gives no particular definition to the term “attributes” as it is used in the claims. The broadest reasonable construction of the term in light of the Specification as interpreted by one of ordinary skill in the art is that it covers properties of the document, such as its color. It is common knowledge that the printing costs for a document in color is greater than if printed in black and white. Given this knowledge, determining printing costs for printing full-sized documents based upon its attributes, like color, would have been obvious to one of ordinary skill in the art.

Finally, determining printing costs for a full size document given a scaled-down version is well within the knowledge of one having ordinary skill in the printing service field. Printing service shops commonly make these sorts of estimates for customers.

In our view, the claimed features of a network-based printing service retrieving a scaled-down version of a full-sized document to be printed from at least one store via a network and a printing service determining printing costs for printing the full-sized document based upon attributes of the scaled-down version appear to be a combination of the familiar elements of printers retrieving scaled-down versions of a full-sized document over a network, basing printing costs on attributes of a document, and determining printing costs for a full size document given a scaled-down version. The claimed method appears to be the result of combining these well known features with Garfinkle’s printing service. “The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *KSR Int’l Co. v. Teleflex Inc.*,

127 S.Ct. 1727, 1739, 82 USPQ2d 1385, 1395 (2007). In that regard, the record does not include objective evidence of unexpected results.

DECISION

The decision of the Examiner rejecting claims 1-4, 7, 11, 13, and 30 under 35 U.S.C. § 102(e) as being unpatentable over Garfinkle and claim 12 under 35 U.S.C. § 103(a) as being unpatentable over Garfinkle in view of Official Notice are reversed.

We remand the application to the Examiner for consideration of a rejection of the claims 1-4, 7, 11, 13, and 30 under 35 U.S.C. §103(a) over Garfinkle for the reasons stated supra. If the Examiner determines that claims 1-4, 7, 11, 13, and 30 should be rejected under 35 U.S.C. §103(a) over Garfinkle, the Examiner may want to consider repeating the rejection of claim 12 under 35 U.S.C. §103(a) over Garfinkle in view of Official Notice for the reasons already on record.

This remand to the Examiner pursuant to 37 CFR § 41.50(a)(1) is made for further consideration of a rejection. Accordingly, 37 CFR § 41.50(a)(2) applies if a supplemental examiner's answer is written in response to this remand by the Board.

REVERSED AND REMANDED

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